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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/694,241      | 10/23/2000  | Nicole Barie         | K 168               | 9230             |

7590 03/01/2005

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SUITE 210  
ALEXANDRIA, VA 22314-2805

EXAMINER

PADMANABHAN, KARTIC

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/694,241

Applicant(s)

BARIE ET AL.

Examiner

Kartic Padmanabhan

Art Unit

1641

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: -

Claim(s) objected to: -

Claim(s) rejected: 3 and 6-10.

Claim(s) withdrawn from consideration: -

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

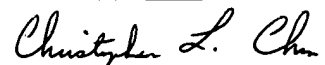
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP ~~1800~~ 1641

Continuation of 5. Applicant's reply has overcome the following rejection(s): applicant's reply has overcome the claim objection of the last office action.

Continuation of 11. of reasons set forth in the previous office action. In addition, applicant's arguments with respect to the alleged advantages of the present invention over the prior art are moot, as the examiner maintains that the combination of references teaches the claimed invention, and as such, would possess the same features as the present invention. In addition, there is no actual showing or evidence to support the alleged advantages of the present invention. Applicant's argument that Swan does not teach a conventional substrate is irrelevant, as such is not required in the claims, and the prior art need not teach that substrate depicted in Applicants' figure 1. Applicant's arguments that Swan does not teach the use of a protein are accurate; however, Chai-Gao or Wessa as secondary reference have been relied upon for this feature. Applicant's arguments that Swan does not teach dextran alone as the material to be connected are erroneous. It is first noted that applicant's arguments distinguish between a coupling compound and the compound to be coupled, a distinction that does not appear anywhere in the claims. Rather, the claims merely require co-immobilization of a TRIMID-protein and dextran. Swan clearly teaches co-immobilization of a chemical species and the coupling compound (Col. 3, lines 29-30). The coupling compound may be dextran (Col. 3, line 62). While the coupling compound of the reference may indeed be different than the coupling compound of the present invention, as long as dextran is co-immobilized with a protein (taught by secondary ref.), the claim limitations are deemed met, as the claims do not require the "coupling compound" to be the protein. Applicant's argument that the examiner's statement that dextran is the polymer from which the coupling compound is derived demonstrates the lack of pertinence of the reference is not convincing, as the claims do not state which component is used for coupling and which is coupled, but merely requires coimmobilization. In terms of the Hubbell reference, applicant argues that the reference does not teach dextran. While this may be true, the claims only generically refer to dextran and do not exclude derivatives of dextran. In addition, even if derivatives of dextran were excluded from the claims (which they haven't been), the use of dextran as a substitute for dextran derivatives would be viewed as a matter of optimization, which would have been obvious to one of ordinary skill in the art at the time of the invention (absent compelling evidence to the contrary). The examiner agrees that the reference does not teach the use of a modified protein as a photolinker, but Chai-Gao has been relied upon to cure this deficiency. It is also once again noted that there is no distinction in the claims between the component to be coupled, and that which facilitates the coupling. Applicant's arguments with respect to Chai-Gao are based on the premise that the reference does not teach immobilization of dextran; however, as a secondary reference, it is only relied upon for teaching a TRIMID-protein used in immobilization and is not required to teach every element of the claims. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hubbell et al. states that virtually any photoinitiator can be used with the method of their reference, and Swan et al. uses a similar diazine to that of Chai-Gao et al. as the photoinitiator, with the only difference being that the diazine in Chai-Gao et al. is substituted. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).